

Remarks

Applicant has carefully reviewed the application in light of the August 20, 2008 Office Action. For at least the reasons below, Applicant submits that the currently pending claims are distinguishable over the cited patent literature. Applicant therefore requests favorable action for this case.

§ 101 Rejection

The Examiner notes that the rejection of claim 21 under 35 U.S.C. § 101 has been withdrawn. Detailed Action ¶ 2. Applicant thanks the Examiner for this finding.

§ 103 Rejections

The Examiner rejects claims 1-33 under 35 U.S.C. § 103(a) for being obvious in view of U.S. Patent No. 6,437,876 issued to Phang et al. ("Phang") and U.S. Patent Pub. No. 2003/0112462 naming Ochiai as the inventor ("Ochiai"). Detailed Action ¶ 3. Applicant disagrees.

To render a claim obvious under § 103 based on a combination of references, an Examiner must establish that the references or the knowledge generally available to one skilled in the art teach or suggest a logical reason for combining the references, that there is a reasonable expectation of success in making the combination, and that the combined references teach or suggest all of the claim's limitations. M.P.E.P. § 2143. Furthermore, the combination cannot alter the principle of operation of a reference. *Id.* The cited patent literature, however, fails to teach or suggest all of the limitations in any of claims 1-33.

Claim 1, for example, is an independent claim containing limitations not taught by the attempted combination of Phang and Ochiai. Claim 1 recites:

A method comprising:
receiving document data for printing a document from an application;
accessing information associated with a sender of the document data; and
formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information, and the accessed information is located between document margins and printer allowable margins.

Nowhere, however, does Phang or Ochiai teach “formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information, and the accessed information is located between document margins and printer allowable margins.”

As the Examiner explicitly finds, Phang does not teach accessed information. Detailed Action ¶ 1. Thus, Phang fails to teach “formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information,” much less that “the accessed information is located between document margins and printer allowable margins.” Additionally, contrary to what the Examiner asserts regarding print regions, *Id.*, Phang fails to teach two print regions – one for print data and the other for information such as headers and footers – because Phang specifically discloses that headers/footers are part of a document:

In some applications, such as those for word processing, extra information such as headers, footers and line numbers are included on the area outside of the work area. In such applications, the work area is defined to encompass more than just the area enclosed by the specified margins. The work area in such applications is defined to cover the full extent of all the extra information added to a page.

col. 1, ll. 40-54. Thus, there is only one print region in Phang.

Ochiai is also deficient regarding these limitations because, as the Examiner explicitly recognizes, Detailed Action ¶ 1, it describes printing user identification information and page information on a back surface of sheet, Abstract; Summary; Fig. 6. Thus, Ochiai also fails to teach “formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information, and the accessed information is located between document margins and printer allowable margins.”

Even though the Examiner recognizes that Ochiai's disclosure is not directly on point with the claimed subject matter, the Examiner still attempts to make an obviousness rejection using it. *Id.* But the Examiner overlooks the fact that Ochiai must be modified to make the rejection, else Phang's system would end up with user identification information and page information printed on a back surface of a sheet, which would not

meet the claim limitations. The Examiner provides no teaching or motivation for making such a modification to Ochiai. Moreover, the Examiner appears to overlook the fact that such a modification would directly override Ochiai's purpose:

The surface of the sheet P with predetermined image information printed thereon faces downwards, and the back surface thereof with the user identification information "Yamada" and page information "Y/X" printed thereon faces upwards so that the user can recognize this information at a glance, during discharging of the sheet P to the sheet receiver 15.

Ochiai ¶ 42. A proposed modification however, cannot, alter the principle of operation of a reference.

Additionally, assuming for the sake of argument only that Ochiai's deficiencies could be overcome, it is not at all clear how Phang and Ochiai could be combined as the Examiner suggests because the combination would result in user identification and page information being inserted into Phang's headers/footers. But if there were already information in these document sections, how would the new information be inserted? What if there was no space for the new information? What if there was an overlap between the new information and the existing information? Such problems do not exist with Ochiai's description of placing the new information on the back of a sheet and, hence, are not taught or suggested by Ochiai. This also again illuminates that teachings and motivations need to be present to modify Ochiai to read on the claim.

For at least these reasons, Applicant submits that Phang and Ochiai fail to teach or suggest the limitations of claim 1. Applicant therefore requests the Examiner to withdraw the § 103 rejection of this claim.

Claim 2-13 depend from claim 1 and, hence, contain all of its limitations, which have already been shown to distinguish over the attempted combination of Phang and Ochiai. Claims 2-13 also contain additional limitations that neither Phang nor Ochiai teaches or suggests.

Claim 2, for example, recites "receiving a request to format information associated with a sender of document data; and generating a user interface that allows formatting of information associated with a sender of document data." Nowhere,

however, does Phang or Ochiai teach such limitations. Applicant notes the Examiner's assertions to the contrary regarding Phang, Detailed Action ¶ 3, but the portions of Phang on which the Examiner relies merely describe software routines (e.g., an application 4, a graphical device interface 10, and a print driver 8) that communicate with each other to carry out a print job, col. 8, l. 59 – col. 4, l. 10, and an application 4 providing an interface for a user to select whether an image should be scaled according to the printable area of a medium, col. 5, ll. 38-55. And while the Examiner believes that these citations illustrate that a user can select a margin emulation feature, which may have an effect on the appearance and position of the sender data, Detailed Action ¶ 1, the Examiner appears to overlook the fact that a request to format information associated with a sender of document data is to be received and a user interface that allows formatting of information associated with a sender of document data is to be generated. Thus, the fact that a user may specify whether to scale an image is not directly relevant to these features. Moreover, it is not clear from Phang whether such a scaling would have any effect on sender data. col. 5, ll. 38-55. Thus, Phang fails to teach “receiving a request to format information associated with a sender of document data” or “generating a user interface that allows formatting of information associated with a sender of document data.”

As another example, claim 3 specifies that “the user interface allows specification of the orientation of information associated with a sender of document data.” Nowhere, however, does Phang or Ochiai teach such limitations. Applicant notes the Examiner's assertions to the contrary regarding Phang, but the portion of Phang on which the Examiner relies merely describes an application 4 providing an interface for a user to select whether an image should be scaled according to the printable area of a medium, col. 5, ll. 38-55. While the Examiner believes that these citations teach that a user can select a margin emulation feature, which has an effect on the appearance and position of the sender data, Detailed Action ¶ 1, the Examiner appears to overlook the fact that the user interface is to allow specification of the orientation of information associated with a sender of document data. Thus, the fact that a user may specify whether to scale an image is not directly relevant to these features. Moreover, it is not clear from Phang whether such a scaling would have any effect on sender data. col. 5, ll. 38-55. Thus,

Phang fails to teach that “the user interface allows specification of the orientation of information associated with a sender of document data.”

As a further example, claim 8 recites “initiating an alert if the accessed information for the formatted page does not fit between the document margins and the printer allowable margins.” Nowhere, however, does Phang or Ochiai teach such limitations. Applicant notes the Examiner's assertions to the contrary regarding Phang, Detailed Action ¶ 1, but the portion of Phang on which the Examiner relies merely describes that a user will be warned if the margins of a work exceed the margins of a printer. col. 2, ll. 23-35. But as discussed with respect to claim 1, the work itself, which includes headers and footers, *Id.*, fails to include any of the data from Ochiai. Thus, Ochiai fails to even remotely suggest “initiating an alert if the accessed information for the formatted page does not fit between the document margins and the printer allowable margins.”

As another example, claim 12 specifies that “accessing information associated with a sender of the document data comprises querying a database comprising sender associated information.” Nowhere, however, does Phang or Ochiai teach such limitations. Applicant notes the Examiner's assertions to the contrary regarding Ochiai, but the portion of Ochiai on which the Examiner relies at best describes that a user identification information generator section 43 generates and temporarily stores user identification information data and a control/driver circuit section 36 controls a printer engine based, among other things, on the user identification information data stored in the user identification information generator section 43. ¶¶ 31-33. This fails to teach or suggest “querying a database comprising sender associated information.”

For at least these reasons, and for the reasons given with respect to claim 1, Applicant submits that the attempted combination of Phang and Ochiai fails to teach or suggest the limitations of claims 2-13. Applicant therefore requests the Examiner to withdraw the § 103 rejections of these claims.

Claim 14 is another independent claim, and contains limitations analogous to those of claim 1. For at least the reasons discussed with respect to claim 1 therefore,

Applicant submits that claim 14 also contains limitations that distinguish over the attempted combination of Phang and Ochiai.

Claims 15-20 depend from claim 14 and, hence, contain all of its limitations, which have already been shown to distinguish over the attempted combination of Phang and Ochiai. For at least the reasons given with respect to claims 2-13, claims 15-20 also contain additional limitations not taught by the attempted combination of Phang and Ochiai. For at least these reasons, Applicant submits that claims 15-20 are distinguishable over Phang and Ochiai.

Claim 21 is another independent claim containing limitations analogous to those of claim 1. For at least the reasons discussed with respect to claim 1 therefore, Applicant submits that claim 21 also contains limitations that distinguish over the attempted combination of Phang and Ochiai.

Claims 22-29 depend from claim 21 and, hence, contain all of its limitations, which have already been shown to distinguish over the attempted combination of Phang and Ochiai. For at least the reasons given with respect to claims 2-13, claims 22-29 also contain additional limitations not taught by the attempted combination of Phang and Ochiai. For at least these reasons, Applicant submits that claims 22-29 are distinguishable over Phang and Ochiai.

Claim 30 is another independent claim containing limitations analogous to those of claim 1. For at least the reasons discussed with respect to claim 1 therefore, Applicant submits that claim 30 also contains limitations that distinguish over the attempted combination of Phang and Ochiai.

Claims 31-32 depend from claim 30 and, hence, contain all of its limitations, which have already been shown to distinguish over the attempted combination of Phang and Ochiai. For at least the reasons given with respect to claims 2-13, claims 31-32 also contain additional limitations not taught by the attempted combination of Phang and Ochiai. For at least these reasons, Applicant submits that claims 31-32 are distinguishable over Phang and Ochiai.

Claim 33 is another independent claim containing limitations analogous to those of claim 1. Claim 33 contains limitations analogous to those of claims 1, 3, 8, and 12.

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For at least the reasons discussed with respect those claims therefore, Applicant submits that claim 33 also contains limitations that distinguish over the attempted combination of Phang and Ochiai.

Conclusion

Applicant submits that a good faith effort has been made to advance the prosecution of this application and that the application is allowable over the rejections expressed in the Office Action. Applicant therefore requests favorable action for this case. If, however, any issues exist that may be advanced by telephone conference, Applicant requests that the Examiner contact its below-listed attorney.

Applicant believes that all of the Examiner's rejections of the application have been addressed. Thus, Applicant's failure to address any objections or rejections should not be taken as acquiescence to any finding of the Examiner. Moreover, Applicant's arguments herein against the Examiner's findings should not be construed as Applicant's only basis for countering the findings. Applicant has made these arguments to illustrate the errors in the Examiner's findings and to expeditiously move the case forward.

Applicant does not believe that this paper requires any adjustment in fees. If, however, applicant is mistaken, please apply any charges or credits to deposit account 05-0765.

Respectfully submitted,

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